

U.S. Serial No. 09/821,687

Attorney Docket No. 081356-0162

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

At the time of captioned Office Action, claims 1-36 were pending in the application. Claims 1, 2, 9-20 and 24-36, drawn to non-elected invention, remain withdrawn from further consideration.

Without acquiescing to the propriety of the Examiner's rejections, Applicants have amended claims 4, 6, 21 and 23 and cancelled claims 3, 5, 7 and 22 to set forth the subject matter of the elected invention more clearly. Support for the amendments is found in the specification at page 3, line 13 and 24; page 7, 3rd full paragraph, lines 2-5; page 21, lines 19-20; and Figure 1.

Applicants reserve the right to pursue the subject matter of the non-elected and cancelled claims in one or more divisional applications.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier. These amendments do not go beyond the original disclosure of the application.

Upon entry of these amendments, claims 4, 6, 21 and 23 will be under examination.

Basis for Amending the Specification:

Applicants respectfully request the withdrawal of the petition against the restriction requirement that was filed on July 7, 2003. To this effect, Applicants have attached a Request for Withdrawal of Petition in a supplemental document.

SEQ ID NO:2 encompasses amino acids 401-561 of the SYNCRIP protein and is devoid of amino acids 1-400 of the SYNCRIP protein. As demonstrated on page 28, section 6(ii) and in Figure 8 of the original specification, the protein comprising the amino acid shown in SEQ ID NO:2 does not have RNA binding activity but has Synaptotagmin protein binding activity. Thus, it appears that rather than the usage of the phrase "RNA binding

U.S. Serial No. 09/821,687

Attorney Docket No. 081356-0162

activity" throughout page 8, second and third full paragraphs, the phrase "Synaptotagmin binding activity" is preferable. This amendment is properly supported in the specification as described above and does not constitute any new matter.

Objection to the Specification and Claims

The Examiner contends that the amino acid sequences disclosed in Figure 2 are without appropriate sequence identifier and requires the Applicants to correct this defect. To complete the current reply to this Office Action, the Examiner requires the Applicants to return "a copy of the attached Notice to Comply with the reply." To date, Applicants have not received such copy as indicated by the Examiner; however, with respect to Figure 2, Applicants will submit a supplemental Sequence Listing that incorporates a new SEQ ID NO assigned to the amino acid sequence of mouse hnRNPR (Clone 18).

Applicants have cancelled claims 3, 5, 7 and 22, which are drawn to non-elected subject matter. Applicants, however, reserve the right to pursue the subject matter of these claims in one or more divisional applications.

Rejections Under 35 U.S.C. §112, 1st Paragraph

In issuing this rejection, the Examiner considers claims 4 and 6 as genus claims that cover a "wide array of molecules" having a retained RNA binding activity and contends that the specification does not disclose how the "structure of this myriad of sequences" recited in these claims relate to RNA binding activity. The Examiner, therefore, concludes that the specification fails to provide teachings and guidance as to the structure-function relationship of the recited DNA sequences.

To address the Examiner's concerns, Applicants have amended claims 4 and 6 to recite the isolated nucleic acid molecules that encode a protein comprising the amino acid sequence as shown in SEQ ID NO:4 and that comprise a nucleotide sequence spanning from position 154 to position 1836 of SEQ ID NO:3, respectively. As for claims 21 and 23, Applicants have replaced the term "gene" in these claims with "nucleic acid molecule."

In view of the foregoing amendments, Applicants respectfully request reconsideration and withdrawal of the rejection.

U.S. Serial No. 09/821,687

Attorney Docket No. 081356-0162

Rejections Under 35 U.S.C. §102(a)

The Examiner rejects claims 4, 6, 21 and 23 as being anticipated by Mizutani *et al.*, *J. Biol. Chem.* 275: 9823-9831, 2000. Applicants disagree with the Examiner on the ground that the cited reference is a publication of Applicants' own invention and has a publication date of March 31, 2000. Thus, this reference is available as prior art. However, this date is less than one year prior to the Applicants' effective filing date, March 30, 2001. Therefore, the novelty of the present invention should not be denied by the cited reference, since it is not the invention of another and is, therefore, inadmissible under section 102(a).

Although the authors of the cited application include other individuals (namely, M. Fukuda, K. Ibata, and Y. Shiraishi), it is the Applicants themselves, Mizutani and Mikoshiba, who were the inventors of the present invention. If required, to remove the cited reference, Applicants will provide a declaration under Rule 131 in a supplemental response.

In light of the foregoing remarks, Applicants submit that the cited reference is not novelty-defeating under section 102(a) and request reconsideration and withdrawal of this rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited.

U.S. Serial No. 09/821,687

Attorney Docket No. 081356-0162

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date September 8, 2003



FOLEY & LARDNER
Customer Number: 22428
(703) 333-1000
22428

Matthew E. Mulkeen
Attorney for Applicants
Registration No. 44,250

PATENT TRADEMARK OFFICE
Telephone: (202) 672-5300
Facsimile: (202) 672-5399

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees, and applicant(s) hereby petition for any needed extension of time.

Title: RNA-BINDING PROTEIN
Inventor(s): Katsuhiko Mikoshiba Dkt. No. 081356-0162
Appl. No.: 09/821,687 SAGE (9/10/03)

- Amendment and Supplemental Response (3 pgs.)

Commissioner for Patents:

Please acknowledge receipt of the above-identified documents by
applying the U.S. Patent and Trademark Office receipt stamp hereto and mailing
this card.

Date Filed: September 10, 2003

Respectfully,
Foley & Lardner
SAGE/MEMU:mb

